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1774

PATENT
CASE NAME/No.: SP01-136

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: SCHISSEL DAVID, et al.

Serial No: 10/056,940

Filing Date: 1/25/2002

Title: OPTICAL FIBER WITH AN IMPROVED
PRIMARY COATING COMPOSITION

Art Group Unit: 1774

Examiner: Jill M. Gray

RESPONSE

Commissioner for Patents
Alexandria, VA 22313-1450

RESPONSE TO EXAMINER'S RESTRICTION REQUIREMENT

In the Office Action dated January 15, 2004, designated as Paper No. 5 in the above-captioned application, the Examiner issued a Restriction Requirement identifying the following groups of claims as being drawn to potentially distinct inventions:

- Group I. Claims 1 – 42 and 75 – 78, drawn to an optical fiber, classified in class 385, subclass 123;
- Group II. Claims 43 – 53 and 63 – 39, drawn to a coating and method, classified in class 522, subclass 90;
- Group III. Claims 54 – 62, drawn to a method of coating an optical fiber, classified in class 427, subclass 163.2; and
- Group IV. Claims 70 – 74, drawn to a method of making an oligomer, classified in class 528, subclass 75.

The Examiner asserted that these inventions may be regarded as independent and distinct from one another because of the following reasons:

1. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship.
2. Inventions I and III are related as process of making and product made.

Applicants respectfully traverse the Examiner's Restriction Requirement on the grounds that the proposed inventions are inextricably intertwined, and prosecution of the proposed groups of claims together would be most effective for the Office. In order to conduct a comprehensive search regarding any one of the groups, including the group provisionally elected above, it would be inherently necessary to review the same pertinent

fields and classes of prior art relating to the other groups. Moreover, the important questions of patentability and claim interpretation are likely to be based on substantially similar issues and evaluations for each group of claims, and would require consideration of the same prior art, and combined prosecution is therefore less likely to result in inconsistent or conflicting file histories.

As such, Applicant respectfully requests that the Examiner withdraw the Restriction Requirement in the next subsequent Office Action, and continue prosecution of Groups I- IV, claims 1-18 and 20-78 together with one another. However, in the event the Examiner does not withdraw the Restriction Requirement, applicants elect Group I (claims 1-42 and 75-78) for examination, with traverse.

Applicants believe that no extension of time is necessary to make this Response timely. Should Applicants be in error, Applicants respectfully request the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Robert L. Carlson at 607-974-3502.

Respectfully submitted,

CORNING INCORPORATED

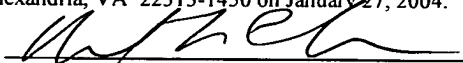


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Date: January 27, 2004

CERTIFICATE OF MAILING UNDER 37 C.F.R.

§ 1.8: I hereby certify that this paper and any papers referred to herein are being deposited with the U.S. Postal Service, as first class mail, postage prepaid, addressed to Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 27, 2004.


Robert L. Carlson, Signature